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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/582,705	06/30/2000	Shinji Yoshimura	44243P	6865
2292	7590	07/16/2004	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747			ZIRKER, DANIEL R	
			ART UNIT	PAPER NUMBER

1771

DATE MAILED: 07/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- ☒ Responsive to communication(s) filed on 5/24/04
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1, 2, 4, 7-10 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1, 2, 4, 7-10 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☒ All ☐ Some* ☐ None of the:
- ☒ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No. _____.
- ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. The Examiner again notes that the specification in the "Disclosure of the Invention" section should eliminate the references (page 2, lines 18, 25 and 30) to specific claims, which is clearly improper and has not been mentioned by applicants in their response.

3. Claims 1, 2, 4, and 7-10 are rejected under 35 U.S.C. § 103(a) as being unpatentable over JP -383, substantially for reasons of record, as most recently set forth in paragraph No. 4 of Paper No. 011304, together with the following additional observations. The Examiner initially notes that newly submitted claims 9 and 10 lack the thickness range of 10 to 70 microns for the "substantially flat ring-like body" element and accordingly JP -383 is believed to be an anticipation of claims 9 and 10 except for the fact that the reference fails to teach the fact that the "substantially flat ring-like body" has printing on the inner peripheral surface thereof, which as earlier stated is believed to be well within the ordinary skill of the art. With respect to the product-by-process limitation that the wound adhesive tape articles set forth in each of applicants' independent claims are prepared in a process comprising the step of winding the tape around the substantially flat ring-like body,

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note that the reference teaches, e.g. page 2, last complete paragraph, that the wound adhesive tape article of the reference is prepared in an identical manner.

Turning to the remaining claims 1, 2, 4, 7 and 8, and the accompanying Declaration of co-inventor Suitsu, it must be noted that the brief comparison which the Declaration dicscusses is substantially flawed for several reasons. Initially it is noted that in each of these claims the thickness limitation of the substantially flat sheet material ranges from 10 to 70 microns, which while not believed to touch the thickness range taught in the reference at page 3, first complete paragraph, wherein it is taught that preferably the thickness of the reference's substantially flat sheet material can be as little as "about" 0.1mm, i.e. 100 microns, it is nevertheless clear that the thickness of the reference embodiments are very close to that of the upper limit of the thicknesses claimed by applicants. Applicants' Declaration states that a crease occurs in the center of the wound adhesive tapes of the reference, but nowhere is it stated just what thickness embodiments are being compared against, and nowhere can it be ascertained from the Declaration whether or not a crease would occur in the upper limit of applicants' claimed range of thicknesses of the formed wound adhesive tape. Accordingly, applicants' remarks such as set

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forth (Response, page 8, first complete paragraph) that the claimed invention wound tapes are free from this problem set forth in the prior art is, it is respectfully submitted, have not been proven on the record. Additionally, applicants' remarks (Response, bridging paragraph pages 9 and 10) concerning the thicknesses of the ring-like body of JP -383 and as such JP -383 would not be sufficiently flexible and readily deformable to allow fingers of the hand to be readily inserted inside the ring-like core to facilitate the rewinding of the adhesive tape thereon" has, it is respectfully submitted, not been proven on the record. In summary, the Examiner believes claims 1, 2, 4, 7 and 8 differ from the closest embodiments taught in the reference by only a few microns if at all, and it has simply not been shown on the record that a non-obvious property existing in the claimed genus of articles results from this minor thickness differential, applicants' comments to the contrary notwithstanding. Finally, as was briefly touched upon in the discussion of claims 9 and 10, it is again noted that the newly presented product-by-process limitations relating to winding the tape around the substantially flat sheet material to form the wound adhesive tape are also taught by the reference, as was previously pointed out. In conclusion, the Examiner also notes that at page 13, top paragraph of the response applicants set forth a recitation of

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alleged advantages which the Examiner respectfully submits have not been issues during the prosecution, such as the wound adhesive tapes not breaking and also do not malform, and accordingly this argument is also believed to be entitled to little merit.

4. **THIS ACTION IS MADE FINAL.** Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

5. Any inquiry concerning this communication or earlier

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communications from the examiner should be directed to Daniel Zirker whose telephone number is (571) 272-1486. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (571) 272-1478. The fax phone number for this Group is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either private PAIR or public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dzirker:cdc

July 15, 2004

DANIEL ZIRKER
PRIMARY EXAMINER
GROUP ~~1300~~
1700

Daniel Zirker